

Remarks

Applicants have carefully reviewed the application in light of the Office Action dated May 13, 2003. At the time of the Office Action, Claims 1-59 were pending in the application. Applicants respectfully traverse the Office Action and the Official Notices included therein. Accordingly, Applicants respectfully request reconsideration of the pending claims and favorable action in this case.

Section 102 Rejections

The Examiner rejects Claims 1, 2, 11, 14, 16, 31, 32, 43, and 45 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,038,554 issued to Vig (hereinafter “*Vig*”). Applicants respectfully request reconsideration of this rejection of Claims 1, 2, 11, 14, 16, 31, 32, 43, and 45.

At the outset, Applicants submit that the primary reference, *Vig*, is only tangentially related to the present claims and is improper for this rejection. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987); M.P.E.P. § 2131. Moreover, the identical invention must be shown in as complete detail as is contained in the claim. *See Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989); M.P.E.P. § 2131. *Vig* fails to anticipate many of the elements as set forth in the present claims such as, for example, Claim 1.

Claim 1 recites:

A method for measuring intellectual capital comprising ... identifying one or more intellectual capitals to be measured, wherein the intellectual capital comprises human capital, structural capital, and external capital ... selecting a set of metrics that are present within the identified intellectual capitals, wherein the set of metrics comprises one or more monetary metrics and one or more non-monetary metrics ... assigning values to the set of selected metrics ... scaling the set of valued metrics, wherein the scaled non-monetary metrics and monetary metrics are operable to be mathematically associated ... and quantifying the identified intellectual capitals based on the scaled metrics.

In the Office Action, the Examiner asserts that “identifying one or more intellectual capitals to be measured, wherein the intellectual capital comprises human capital, structural capital, and external capital” of Claim 1 is disclosed at “Col. 64, lines 4-5, represented by the

probed entity” in *Vig*. Applicants respectfully traverse the Examiner’s rejection and submit that the Examiner fails to provide any details or reasoning as to how the “probed entity” of *Vig* anticipates “the intellectual capital comprises human capital, structural capital, and external capital” as recited, in part, in Claim 1.

A closer look at *Vig* reveals that the cited “probed entity” references a “Doctor’s Societal Worth,” (*Vig*, Figure 5, element 901), not “one or more intellectual capitals to be measured” as recited, in part, by Claim 1. The societal worth of any probed entity in *Vig* is “in terms of a hypothetically ideally informed society and/or a theoretically optimally knowledgeable unique individual.” *Vig*, 69:11-14. *Vig* then asserts that surveys are given to these hyper-informed persons to

unearth every currently discoverable characteristic, advantage, disadvantage, quality, trait, virtue, endowment, peculiarity, feature, distinction, property, effect, component, ingredient, part and aspect relevant to said probed entity group or concept, be said probed test entity group pertaining to morals, laws, rules, behavior, thinking sports, fairness, fights, wars, peace, agreements, respectability, power, regulations, prestige, social justice, music, art, taste, fashion, politics, politicians, policies, the concept of ‘good’ and ‘bad’, philosophies, concepts, religion, laws, elections, propositions, objects, goods, services or any other known or imaginable entity.

Id., 69:18-39. However, Applicants fail to see how any of this teaches, suggests, or discloses “the intellectual capital comprises human capital, structural capital, and external capital” and respectfully request the Examiner provide such reasoning.

Vig also fails to teach, suggest or disclose “selecting a set of metrics that are present within the identified intellectual capitals, wherein the set of metrics comprises one or more monetary metrics and one or more non-monetary metrics” as recited, in part, by Claim 1. The Office Action asserts that this recitation of Claim 1 is disclosed at “Col. 73, lines 49-54, where metrics are represented by the characteristics, quality, trait, etc., Col. 6, line 65-Col. 7, line 4, where the monetary worth represents the monetary metric, Col. 6, lines 65-67, where non-monetary metrics are represented by the ‘ride quality’ and ‘reliability’” in *Vig*. Applicants respectfully traverse the Examiner’s position.

The cited monetary worth (asserted by the Office Action to equate with “monetary metrics” recited by the present claims) is the result of *Vig*’s valuation, not a “metric” used in computing *Vig*’s valuation. For example, *Vig* discloses that the system is for “discovering both an entity’s actual current societal monetary value and its contemporary monetary

worth.” *Vig*, Abstract. In another example, *Vig* teaches that what “an entity is, does and has are what matter *as to its true monetary worth or ranking.*” *Vig*, 2:58-59 (emphasis added). Moreover, *Vig* states that “[p]rice is *never* a factor of value.” *Id.*, 2:61 (emphasis added). Therefore, *Vig* fails to teach, suggest, or disclose “wherein the set of metrics comprises one or more monetary metrics and one or more non-monetary metrics” as recited by the Claim 1.

For at least these reasons, *Vig* fails to teach, suggest, or disclose various elements of Claim 1. Claims 2, 11, 14, and 16 depend from Claim 1, shown above to be allowable. For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 2, 11, 14, and 16. For at least the reasons stated above with regard to Claim 1, Applicants respectfully request reconsideration and allowance of independent Claim 31. Claims 32, 43, and 45 depend from Claim 31, shown above to be allowable. For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 32, 43, and 45.

Section 103 Rejections

The Examiner rejects

- Claims 3, 4, 12, 13, 15, 17, 18, 19, 21, 33, 34, 41, 42, 44, 46, 47, 48, and 50 under 35 U.S.C. § 103(a) as being unpatentable over *Vig* and further in view of U.S. Patent No. 6,411,936 issued to Sanders (hereinafter “*Sanders*”);
- Claims 5, 20, 22-27, 35, 49, and 51-56 under 35 U.S.C. § 103(a) as being unpatentable over *Vig* and further in view of *Sanders* and further in view of U.S. Patent No. 6,321,205 issued to Eder (hereinafter “*Eder* ‘205’”);
- Claims 6, 7, 9, 10, 36, 37, 39, and 40 under 35 U.S.C. § 103(a) as being unpatentable over *Vig* and further in view of U.S. Patent No. 6,393,406 issued to Eder (hereinafter “*Eder* ‘406’”); and
- Claims 8, 28, 29, 30, 38, 57, 58, and 59 under 35 U.S.C. § 103(a) as being unpatentable over *Vig* and further in view of *Eder* ‘406 and further in view of *Sanders*.

For at least the reasons stated above with regard to Claim 1, *Vig* – even in view of *Sanders*, *Eder* ‘205, and *Eder* ‘406 – fails to teach, suggest, or disclose various aspects of Claims 3-10, 12-13, 15, 17-30, 33-42, 44, and 46-59. Claims 3-10, 12-13, 15, and 17-30 depend from Claim 1, shown above to be allowable. For at least these reasons, Applicants

respectfully request reconsideration and allowance of Claims 3-10, 12-13, 15, and 17-30. Claims 33-42, 44, and 46-59 depend from Claim 31, shown above to be allowable. For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 33-42, 44, and 46-59.

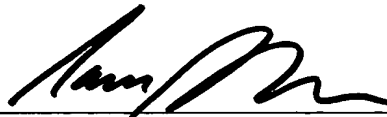
Conclusion

Applicants have now made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all Claims.

Although no fees are believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

If there are matters that can be discussed by telephone to further the prosecution of this application, Applicant respectfully requests that the Examiner call its attorney at the number listed below.

Respectfully submitted,
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